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03 AUG 2006

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In re Application of:	:	
TAI, Kenny, et al.	:	DECISION ON PETITION UNDER
U.S. Application No.: 10/560,194	:	37 CFR 1.47(a)
PCT No.: PCT/SG2004/000176	:	
International Filing Date: 10 June 2004	:	
Priority Date: 11 June 2003	:	
Attorney's Docket No.: 003D.0083.U1(US)	:	
For: RECEPTACLE CONNECTOR	:	
ASSEMBLY FOR IC CARD AND IC	:	
CARD CONNECTOR	:	

This decision is issued in response to applicants' "Petition Under 37 CFR 1.47(a)" filed 11 April 2006. Applicants have paid the required petition fee.

BACKGROUND

On 10 June 2004, applicants filed international application PCT/SG2003/000176. The international application claimed a priority date of 11 June 2003, and it designated the United States. On 16 December 2004, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 11 December 2005.

On 08 December 2005, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 15 March 2006, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirement (Form PCT/DO/EO/905) indicating that an executed declaration in compliance with 37 CFR 1.497 and the surcharge for filing the oath or declaration later than thirty months after the priority date was required.

On 11 April 2006, applicants filed a response to the Notification Of Missing Requirements. The submission includes the required surcharge payment and the petition under 37 CFR 1.47(a) considered herein. The petition seeks acceptance of the application without the signature of inventor Scott LU, whom applicants assert has refused to execute the application.

DISCUSSION

A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the nonsigning inventor; (3) an oath or declaration executed by the other inventors on behalf of themselves and the nonsigning inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Applicants here have submitted the required petition fee, and the petition expressly states the last known address of the non-signing inventor. Items (1) and (2) are therefore satisfied.

Regarding item (3), section 409.03(a) of the Manual of Patent Examining Practice (MPEP) states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, applicants have filed a declaration executed by the two cooperating inventors and containing an unsigned signature block for the non-signing inventor. This declaration may be accepted as having been executed by the signing inventors on their own behalf and on behalf of the non-signing inventor. Item (3) is therefore satisfied.

Regarding item (4), MPEP section 409.03(d) states that “[a] copy of the application papers should be sent to the last known address of the non-signing inventor, or, if the non-signing inventor is represented by counsel, to the address of the non-signing inventor’s attorney.” The MPEP also states the following:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Here, as evidence of the inventor’s refusal to sign the application, applicants have provided a statement from attorney Mark Harrington, with supporting documents. The statement provides firsthand evidence that a request for signature, with a copy of the complete application, was forwarded to the last known address of the non-signing inventor via Federal Express, and that no reply was received. However, the inventor’s failure to respond to a single mailing, receipt of which has not been confirmed, is insufficient on its own to support a conclusion that the inventor has refused to sign the application.

Mr. Harrington’s statement also refers to the separate delivery of the declaration to the non-signing inventor (by the inventor’s wife), and a statement of express refusal to sign the

declaration made by the non-signing inventor to an unnamed former co-worker. Applicants have not, however, provided the firsthand evidence required to confirm such facts (for example, a statement from the former co-worker to whom the refusal was made). Absent such firsthand evidence, the express refusal referred to by Mr. Harrington cannot be considered in determining whether the inventor has refused to sign the application.

Applicants must supplement the present submission either with firsthand evidence confirming the inventor's express refusal to execute the application papers, or, in the alternative, additional evidence to confirm that the inventor has constructively refused to sign the application. Any showing of constructive refusal should include evidence that a request for signature, with a copy of the complete application papers, has been provided to the inventor at his current address (for example, a signed delivery receipt, or other evidence that the address being used for the inventor is current). Until such supplemental materials are provided, item (4) is not considered satisfied.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and must include the additional materials required to satisfy item (4) of a grantable petition, as discussed above. No additional petition fee is required.

Failure to file a proper response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a)

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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